

REMARKS

Drawings:

In an Office Action mailed May 16, 2005, the Examiner objected to the drawings. Applicants have amended the drawings to overcome the Examiner's rejections. None of these amendments has narrowed the scope of the respective claims.

Applicants note that all but two of the objections (para. 1 below) relative to the drawings made by the Examiner were overcome by corrections made to the drawings filed January 9, 2004 and November 1, 2004. The drawings were properly labeled as "Replacement Sheets" in the header. Applicants note that the Examiner has refused to accept the corrected drawings, apparently because of the two new minor objections. Since the Examiner has repeated her litany of objections, it is difficult to ascertain exactly what objections are new, and which ones are old. Accordingly, as in past response, Applicants respectfully request that, if any objections remain, the Examiner indicate with *particularity* such objections so that Applicants can be address them on an expedited basis. The objections, as best understood by Applicants, are as follows:

1. The Examiner has objected to Figure 16 on the basis that the line from the left reference number 38 is not dashed, and the commas still show between reference numbers 45 and 49. Applicants have made the line from reference number 38 dashed, and submit that the commas are *not* shown between reference numbers 45 and 49, but rather are merely part of the dashed line leading to number 49 in each pair. Applicants have further clarified the lines.
2. The Examiner has objected to Figure 15 on the basis that the line from the right reference number 74 is not dashed. Applicants have made the line dashed.

3. The Examiner has objected to Figures 17 and 18 for purportedly having extraneous text. Applicants submitted corrected drawings on January 9, 2004 and again on November 1, 2004 that removed the text from those drawings. Applicants have resubmitted the corrected drawings for the Examiner's review.
4. The Examiner has objected to Figure 3 for not having a dashed line from reference number 145. Applicants submitted corrected drawings on January 9, 2004 and again on November 1, 2004 that made the lead line from reference number 145 dashed. Applicants have resubmitted the corrected drawings for the Examiner's review.
5. The Examiner has objected to Figure 14 for not having a dashed line from reference number 51. Applicants submitted corrected drawings on January 9, 2004 and again on November 1, 2004 that made the lead line from reference number 51 dashed. Applicants have resubmitted the corrected drawings for the Examiner's review.
6. The Examiner has objected to Figures 12 and 13 purportedly for not having a lead line from reference number 128 denoting the same aspect as in Figures 3-9B. As noted in the response dated November 1, 2004, Applicants note that reference number 128 refers to a "base" of an insert member, not a "surface" as referenced in the Office Action (at 2, para. 5). The lead lines for reference 128 are consistently directed to such a base in FIGS. 4-9, 12 and 13. Applicants do not understand the Examiner's objection, and *again* ask for further clarification should a problem remain.
7. The Examiner has objected to FIGS. 15-16 for not providing a line from reference numbers 45 and 49. Applicants submitted corrected drawings on January 9, 2004 and November 1, 2004 that provided

separate lead lines for reference numbers 45 and 49. Applicants have resubmitted the corrected drawings for the Examiner's review.

8. The Examiner has objected to the drawings for not having dashed lines from reference numbers 14, 16, 36, 38, 74 and 72. Applicants submitted corrected drawings on January 9, 2004 and again on November 1, 2004 that provided dashed lines for those reference numbers. Applicants have resubmitted the corrected drawings for the Examiner's review.
9. The Examiner has objected to Figure 16 for having leg elastics denoted by references numbers 36 and 38. As set forth in prior responses, Applicants respectfully disagree. Reference number 36 refers to waist elastics, while reference number 38 refers to leg elastics (see Specification at 18, lines 25-30; at 27, lines 23-28).
10. The Examiner has objected to the drawings for not having a dashed line from reference number 37 in Figure 16. Applicants submitted corrected drawings on January 9, 2004 and November 1, 2004 that provided a dashed line for reference number 37. Applicants have resubmitted the corrected drawings for the Examiner's review.
11. The Examiner has objected to the drawings for not having reference number 70, as set forth in the Specification at page 33, lines 30-31. Applicants submitted corrected drawings on January 9, 2004 and November 1, 2004 that added reference number 70 to Figure 15. Applicants have resubmitted the corrected drawings for the Examiner's review.

S/N 10/032,701
Ref. No.: 659-920

Claims:

The Examiner has rejected independent claims 11-20 and 31-40 as being anticipated by or made obvious over GB 2267024A to Igaue. The Examiner also has rejected claims 42 and 44 as being made obvious over Igaue in view of U.S. Patent 6,009,558 to Rosch and EP publication No. 0 547 497 A2 or U.S. Patent No. 4,940,464 to Van Gompel.

Rejections of Claims 11-20 and 31-40 Over Igaue:

It appears that the Examiner has largely repeated her rejections relative to Igaue as set forth in the earlier Office Action mailed June 24, 2004. In particular, the Examiner has rejected claims 11-20 and 31-40 over Igaue on the basis of three different arguments, namely that: (1) Igaue inherently anticipates the claimed subject matter, (2) Igaue makes obvious the claimed subject matter and (3) Igaue makes obvious the claimed subject matter, which are asserted to be product by process claims. Applicants respectfully disagree on all counts.

First, it is black letter law that “[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic” (MPEP 2112, citing *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1944, 1957 (Fed. Cir. 1993)). “Inherency may not be established by probabilities or possibilities” (MPEP 2112, citing *In re Roberston*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)).

In the present case, as admitted by the Examiner, Igaue fails to disclose or teach the claimed tear and tensile strengths (Office Action at 4). In addition, however, the Examiner has failed to specify how the materials and perforations of Igaue are “identical” to those of the present application (MPEP 2112). It is clear that merely providing a perforation or line of weakness in a panel does not *necessarily* result in the panel having the claimed tear strength. Rather, the tear strength can

depend on many parameters, including for example and without limitation the type of material and the configuration of the line of weakness. Indeed, Applicants' own data showing a divergence of tear strengths depending on the perforation characteristic nullifies any argument of inherency (Specification at 15, Table I and at 37, Table II).

Applicants also do not understand the Examiner's reference to the language of "undue effort" (Office Action at 4). That language is not in the claims, and the Examiner appears to be reading limitations into the claims. The claims recite a tear strength along the line of weakness, not a line of weakness that is opened without "undue effort." Igaue simply does not disclose or suggest the recited tear strength, regardless of whether it discloses opening a product along a line of weakness.

On the Examiner's second point, Igaue does not suggest and in fact teaches away from the claimed tear strengths. In particular, Igaue is completely silent with respect to tear strengths across a line of weakness, but rather discloses various tensile strengths. As previously noted in Applicants' Amendment filed January 9, 2004 and the Corrected Amendment filed February 11, 2005, Igaue does not disclose and in fact teaches away from *tensile* strengths less than about 6.62 lbf (January 9, 2004 Amendment at 14).

With respect to the claimed tear strengths, Applicants have discovered that the claimed ranges achieve unexpected results, namely that the web can be weakened to a point where a user can easily break the panel along a line of weakness. At the same time, the web can still be processed on a manufacturing line with minimal risk of breaking the web by virtue of using additional fasteners crossing the line of weakness or by virtue of the configuration of the manufacturing line (Specification at 8, line 14 to 9, line 12). In contrast, there is no suggestion that the claimed tear/tensile values would be desirable in the construction of Igaue, since it would be difficult to process the garment due to line breaks and the like associated with such tear/tensile values.

For example, Igaue does not provide any disclosure of using fasteners across a line of weakness or weakening a line of weakness downstream in the manufacturing process.

It is important to note that claims do not have to recite the use of fasteners crossing the line of weakness, as implied by the Examiner (Office Action at 4, lines 2-3 and at 8). Rather, the argument is merely that *Igaue* does not disclose or suggest the claimed line of weakness by virtue of its construction when Igaue is viewed in its entirety without the benefit of hindsight analysis.¹

Third, the Examiner has misconstrued the claims as being a product by process claim. The claimed tear values are *properties* of the body panel, not a process for making the panel. Accordingly, the Examiner's reliance on MPEP 2113 is totally misplaced. Moreover, the Examiner previously noted that the claims did *not* specify any testing protocol (Office Action at 3). Accordingly, it is contradictory later to assert that the claims are limited by the "processing" of testing, such that the claim can be defined as product-by-process claim, all the while ignoring that testing has nothing to do with how the product is made. Indeed, the Examiner has not pointed to any authority for her position that a recited property material, which may be ascertained by testing (not recited), can or should be construed as a product-by-process claim.

Finally, the Examiner has mischaracterized Applicants' previous arguments in her "Response to Arguments." In particular, at page 14 of Applicants' January 9, 2004 response, Applicants *never* argued that tear strength depends on the test used, but rather that many things affect *tensile* strength, as was recited in claim 1. Claim 1

¹ Applicants also do not understand the Examiner's statement that the "body panel is not limited to a single layer of material, i.e. line of weakness can be in only one layer of a multiplayer panel as claimed" (Office Action at 3-4). Claim 1, for example, is not limited to any number of layers - the body panel can be one or more layers, with the one or more layers having a line of weakness formed therethrough.

has been *cancelled*. Moreover, the claims are not directed to process for testing, but rather merely recite properties of a material. Those properties can be ascertained using the testing protocol disclosed in the specification, but the Examiner cannot and should not read into the claims such a protocol to advance her argument of the claims being product-by-process. Indeed, Applicants note that the Examiner has not, in the many Office Actions received in this case, ever asserted that the claims are indefinite or unclear.

For at least these reasons, Igaue does not disclose or suggest all of the limitations of claims 11-20 or 31-40 (with the same analysis applying) and the Examiner's rejections should therefore be withdrawn.

Rejections of Claims 42 and 44:

The Examiner has now rejected for the *first time* claims 42 and 44 over Igaue in view of other new references, even though in two prior Office Actions, Igaue was not cited against those claims. That said, claims 42 and 44 are patentable over Igaue for all of the reasons set forth above with respect to claim 11. In this regard, the Examiner has not asserted that the secondary references supply any of the noted deficiencies.

In addition, however, none of Rosch, or Van Gompel '464 and '497 disclose or suggest front and rear body panels having spaced apart terminal crotch edges formed at least at a midpoint between side edges of respective front and rear body panels, or a crotch member bridging a longitudinally extending gap formed at the midpoints. For example,² the waist containment section 4 of the '464 patent does not

² Applicants assume that the Examiner was referring to the '464 patent at page 6 of the Office Action due to the recitation of reference numbers 18, 20, 24 and 26.

**S/N 10/032,701
Ref. No.: 659-920**

bridge a gap at the midpoints of the side panels 6, 8 (18, 20, 24 and 26). Rather, it is connected along only a side edge thereof (FIG. 1; Col. 3, lines 45-56).

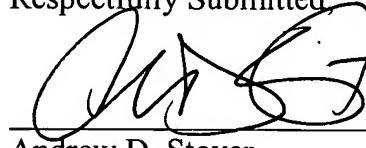
CONCLUSION:

After Amendment, this application has 26 claims, including four independent claims. Applicants previously paid for forty claims including five independent claims. Accordingly, no additional claims fee is believed to be due. If for any reason this application is not considered to be in condition for allowance and an interview would be helpful to resolve any remaining issues, the Examiner is respectfully requested to call the undersigned attorney at (312) 321-4713.

Dated: August 16, 2005

By:

Respectfully Submitted


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